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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,149	07/23/2003	H. Downman McCarty II	HHT-	8274
25175 7590 07/21/2009 BROOKE SCHUMM III Daneker, McIntire, Schumm, Prince, Goldstein et al ONE NORTH CHARLES STREET SUITE 2450 BALTIMORE, MD 21201				
			EXAMINER FLORES SANCHEZ, OMAR	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 07/21/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/625,149

**Applicant(s)**

MCCARTY ET AL.

**Examiner**

Omar Flores-Sánchez

**Art Unit**

3724

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 143-163 is/are pending in the application.
- 4a) Of the above claim(s) 152, 153 and 159-163 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 143-151 and 154-158 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to applicant's amendment received on 05/06/09.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 143, 144, 146, 147, 148, 150, 151 and 156 are rejected under 35 U.S.C. 102(b) as being anticipated by Zetterman (1,409,638).

Zetterman discloses the invention including:

- Claim 143, 146, 148 and 151; a shaft 10 having a striking end (see Fig. 5) and a working end 11; and a shaped polymeric material 13 reinforced by a material selected from the group of fiber or mineral(see col. 3, line 24) to be impacted disposed adjacent to said striking end to avoid direct metal-to-metal contact, said shaped polymeric material having a striking end area 17 of said polymeric material adjacent to said striking end and an impact end area (14 and 21) to be impacted roughly opposite said striking end area, said shaped polymeric material being of sufficient cross-sectional area for transmitting impact upon the impact end area, of appropriate thickness through said cross-sectional area, and of sufficient

modulus to enable greater than sixty-seven per cent impact effectiveness compared to a similar impact tool without said polymeric material disposed adjacent to said striking end (the head of Zetterman is capable of performing the intended use of transmitting impact to enable greater than sixty-seven per cent impact effectiveness (see col. 2, lines 93-95, where the cap is able to insure the effect of the blow would be received by the platform 14).

- Claim 144 and 147; said shaped polymeric material being selected to have the further characteristic of redistributing the sound frequency on impact by a driving force on said impact tool to lower frequency ranges than said impact tool without said shaped polymeric material so that resulting sound and vibration is of lower dB, and less harmful frequency ranges to humans (the head (see col. 1, lines 45-47) of Zetterman is capable of lowering the frequency ranges).
- Claim 150; the shaped polymeric material of Zetterman being shaped so that no edge or surface is presented having a radius of curvature of less than .02 inches.
- Claim 156; the shaped polymeric material being shaped to extend beyond the cross-sectional area of said impact end area (see Fig. 4).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 145 and 149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetterman (1,409,638) in view of Smith (4,497,355).

Zetterman discloses the invention substantially as claimed except for an included angle from the standard 65-70 degree. However, Smith teaches the use of an included angle of 65 degree for the purpose of assuring the effectiveness of the chisel and prolonging its life. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Zetterman by providing the included angle of 65 degree as taught by Smith in order to obtain a device that assures the effectiveness of the chisel and prolong its life.

6. Claims 154-155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetterman (1,409,638).

Zetterman discloses the invention substantially as claimed except for polyamide or fiber-reinforced nylon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Zetterman with polyamide or fiber-reinforced nylon for the purpose of having a stronger material, since it has been held to be within

the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claims 157-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetterman (1,409,638) in view of Vasudeva (6,076,431).

Zetterman discloses the invention substantially as claimed except for a grip and flange. However, Vasudeva teaches the use of a grip and flange for the purpose of having a better support and protection for the user's hand. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Zetterman by providing the grip and flange as taught by Vasudeva in order to obtain a device that have a better support and protection for the user's hand.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. In order to clarify applicant's argument in the summary of interview regarding the meeting the following response is provided in case someone considers the information is relevant to the application. The meeting was scheduled at 11 a.m., however applicant's attorneys arrived early and start the interview with supervisor Boyer Ashley around 10:45 a.m. The Examiner reported to the front desk at 11 a.m. to verify if the attorneys arrived but was inform no one was entered. Then, the Examiner when to Boyer's office to set the interview, but he was not present and no information was left to indicate where the interview would be performed. Suddenly the fire alarm sound and the building was evacuated. The Examiner waits in front of the building to find the supervisor, but he doesn't left of the building.

After long wait to enter the building the Examiner requested again information in the front desk and was informed the attorneys were in the building with the supervisor. Then, the Examiner proceeded to look every possible interview room in order to support the supervisor in the interview. The Examiner arrived to the interview and provided his point of view of the case, and the time lost does not affect the result of the interview.

Mr. Schumm indicated the Examiner Flores Sanchez agree to allow the case if proposed language was added, however, neither the Examiner nor the Supervisor indicated the claims would be allowed, only the claims would overcome the previous rejection.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 571-272-4507. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O. F./  
Examiner, Art Unit 3724  
7/18/2009

/Boyer D. Ashley/  
Supervisory Patent Examiner, Art Unit 3724